

## REMARKS

### Statement of Common Ownership Under 35 U.S.C. § 103(c):

Based on the facts, Application No. 09/264,432 (the present application) and U.S. Patent No. 6,317,791 to Cohn et al. and U.S. Patent No. 6,353,813 to Breese et al. were, at the time the invention of Application No. 09/264,432 was made, owned by, or subject to an obligation of assignment to, either Microsoft Corporation or WebTV Networks, Inc., which is a wholly owned subsidiary of Microsoft Corporation.

Accordingly, under the provisions of 35 U.S.C. § 103(c), U.S. Patent No. 6,317,791 to Cohn et al. and U.S. Patent No. 6,353,813 to Breese et al. are disqualified as prior art for purposes of rejections under 35 U.S.C. § 103(a), rendering all rejections of record moot.

### In the Drawings:

The Office Action stated that Figures 1 and 2 should be designated by a legend such as "Prior Art" because only that which is old is illustrated. Applicants respectfully submit that what represents prior art depends on a variety of circumstances, and Applicants are not willing to concede that Figures 1 and 2 are in fact prior art. For example, the Office Action cites U.S. Patent No. 6,317,791 to Cohn et al. ("*Cohn*") as teaching some of what is shown in Figures 1 and 2. However, as discussed above, Applicants have disqualified Cohn as prior art. (This course of action would be of little benefit had Applicants labeled Figures 1 and 2 as prior art.) It is impermissible for the Examiner to force Applicants into admissions of prior art through objections to the drawings based solely on what the Examiner perceives as old. Such a determination can only be made by citing specific references during examination, all or some of which Applicants may be able to remove or disqualify as prior art. The Examiner's mere assertion that Figures 1 and 2 are old is insufficient. Accordingly, Applicants respond that the objection to Figures 1 and 2 is improper and should be withdrawn.

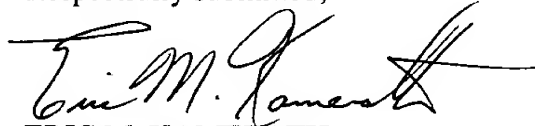
To comply with 37 C.F.R. 184(p)(4), Applicants propose changing reference 110 in Figure 4 to reference 410, which is consistent with the specification text at page 22, lines 14-15.

To comply with 37 C.F.R. 1.84(p)(5), Applicants have amended the specification to remove reference 14 with respect to the remote control device. Applicants further propose adding reference 180 to the "Request Router" block of Figure 3B and have amended the specification accordingly.

Applicants believe this preliminary amendment addresses each issue raised by the Office Action. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 27 day of November, 2002.

Respectfully submitted,



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**022913**

PATENT TRADEMARK OFFICE

In the Specification Text:

The paragraph beginning on page 12 at line 10 has been amended as follows:

Figure 1 illustrates one embodiment of the architecture of an information retrieval system in which the invention may be implemented. In this embodiment, multiple clients systems 10 communicate with a modem pool 12 by means of direct-dial, bi-directional data connections 14, which may be conventional telephone lines, ISDN connections, connections supported by cable television providers, or any other suitable communications channel. Modem pool 12 may be any conventional modem pool, such as those that are currently used for providing access to the Internet and other wide area networks. For example, modem pool 14 may be provided by a local ISP. Thus, modem pool ~~14~~12 may be coupled to a number of server computers, such as remote servers 16, via a conventional network infrastructure, which may be Internet infrastructure 18.

The paragraph beginning on page 13 at line 11 has been amended as follows:

Figure 2 depicts selected elements of one embodiment of a client system that may be used to implements portions of the invention. Client system 10 uses hardware and computer-executable instructions for providing the user with a graphical user interface, by which the user can access Internet resources, send and receive e-mail, and optionally receive other information services. Operation of client system 10 is controlled by a central processing unit (CPU) 26, which is coupled to an application-specific integrated circuit (ASIC) 28. CPU 26 executes computer-executable instructions designed to implement features of client system 10, including some of the steps of methods of the present invention. ASIC 28 contains circuitry which is used to implement certain functions of client system 10. For example, ASIC 28 may be coupled to an audio digital-to-analog converter 30 and to a video encoder 32, which provide audio and video output, respectively, to display device 20 of Figure 1.

The paragraph beginning on page 13 at line 23 has been amended as follows:

Client system 10 may further include an IR interface 34 for detecting infrared signals transmitted by a remote control input device, such as a hand-held device or a wireless keyboard. In response to the infrared signals, IR interface 34 provides corresponding electrical signals to ASIC 28. Alternatively, the signals transmitted by the remote control device 14 may be selected from another suitable region of the spectrum. A standard telephone modem 36 and an ISDN modem 38 are coupled to ASIC 28 to provide connections to modem pool 12 and, via the Internet 18, to remote servers 16. While the client system illustrated in Figure 2 includes both a telephone modem and an ISDN modem, either one of these devices is sufficient to support the communications of the client system. Furthermore, in other embodiments, modems 36 and 38 may be supplemented or replaced with cable modem 40 or another suitable communications device. In other environments, communication may instead be established using a token ring or Ethernet connection.

The paragraph beginning on page 15 at line 5 has been amended as follows:

In one embodiment of the invention, client system 10 is a WEBTV@WebTV client box manufactured by WebTV Networks, Inc. of Palo Alto, California. One reason that WEBTV@WebTV client boxes may be conveniently used with the invention is that they include television interface features that combine Internet browsing with television viewing. For example, the display device that is typically used to graphically display Web resources retrieved by a WEBTV@WebTV system is a conventional television. Furthermore, WEBTV@WebTV client boxes may be adapted to monitor television viewing habits as further disclosed herein. Alternatively, client system 10 may be any of a variety of systems for providing access to the Internet or other information retrieval systems. When a WEBTV@WebTV client box is used as client system 10, the network architecture illustrated in Figure 1 may further include a dedicated server 50, which is dedicated to providing information specifically to WEBTV@WebTV clients boxes.

The paragraph beginning on page 17 at line 10 has been amended as follows:

Client system 10 provides Internet access to the user by means of an Internet browser 56, which may be any conventional or other Internet browser that is adapted or otherwise capable of transmitting information included in user profile 54 as further described herein. For example, when client system 10 is a WEBTV® (combined Internet browsing and television viewing)~~WebTV~~ client box, Internet browser 56 is the Internet browser typically included in WEBTV®~~WebTV~~ client boxes, with the browser being adapted to transmit user profile information. The Internet browser 54 included in client system 10 is one example of means for requesting an information document from a server computer.

The paragraph beginning on page 17 at line 18 has been amended as follows:

A user enters commands to client system using input device 58, thereby requesting an information document from remote server 16. When client system 10 is a WEBTV® (combined Internet browsing and television viewing)~~WebTV~~ client box, input device 58 may be a handheld remote control device or a wireless keyboard that allows the user to select and retrieve desired Internet resources. Alternatively, the input device may be a keyboard, a mouse, or another device that is conventionally used to provide user input to an Internet browser. It is noted that a user may access the Internet by means of the Internet browser 56 at any time after having viewed television programming on display device 20. For example, the user may interrupt television viewing to access the Internet or, alternatively, may access the Internet some time after having stopped watching television programming.

The paragraph beginning on page 20 at line 3 has been amended as follows:

Figure 3B illustrates an embodiment of the invention wherein advertisement selection and insertion are conducted at the level of the Internet service provider. Television programming is viewed by the user and a user profile 154 is compiled at client system 110 in much the same way as described herein in reference to Figure 3A. When a user requests an information

document from a remote server according to this embodiment, the URL is transmitted to the remote server via a request router 180 at the Internet service provider 160. The user profile, however, is transmitted to and stored at Internet service provider 160. Information from user profile 154 may be transmitted each time the user requests resources from the Internet, at the beginning of each Internet session that is served by Internet service provider 160, or periodically at any desired interval. For example, client system 110 may update user profile copy 154' on a daily basis, regardless of whether the user has accessed the Internet during the day. Furthermore, Internet service provider 160 may maintain user profile information associated with a plurality of client systems. The method of selecting advertisements at Internet service provider 160 may be substantially similar to the methods for selecting advertisements at remote server 16 described in reference to Figure 3A. Alternatively, advertisement selection decision unit 164 may select appropriate advertisements for client system 110 and compile a list of appropriate advertisements before any information document is requested by client system 110. In this case, the preselected advertisements are already identified and available for insertion into requested information documents when the user begins to access to the Internet.

The Abstract has been amended as follows:

Systems and methods for selecting and inserting advertisements in an information document displayed to a user, wherein the selection is based at least in part on television programming viewed by the user. The systems and methods may be implemented using the Internet or another information retrieval system that includes a client system and a remote server. The client system monitors television programming viewed by the user and compiles a user profile characterizing the television programming. When the user requests an Internet resource using the client system, the television programming information in the user profile is utilized to select an appropriate advertisement. The advertisement is then inserted in the information document and displayed to the user. Advertisement selection and insertion may be conducted at the remote server, the client system, or at the level of the Internet service provider. Such selection of advertisement increases the efficiency by which Internet advertisements are tailored

to individuals. Instead of advertisements, information relating to the television programming may be retrieved over the Internet and displayed without direct user assistance.